UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,345	03/23/2007	Ulrich Brunet	2008-0001	7518

28078   7590   06/10/2009
MAGINOT, MOORE & BECK, LLP
CHASE TOWER
111 MONUMENT CIRCLE
SUITE 3250
INDIANAPOLIS, IN 46204

EXAMINER
LE, NANCY LOAN T

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
06/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/572,345	BRUNET ET AL.
	Examiner	Art Unit	
	NANCY T. LE	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>13 March 2009</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>20,21,23-32 and 34-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>20, 21, 23-32, 34-39</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

Applicant's Amendment filed on *13 March 2009* is acknowledged.

All references to the capitalized versions of "Applicants" refer specifically to the

Applicants of record. Any references to lower case versions of "applicant" or

"applicants" refer to any or all patent "applicants". Unless expressly noted otherwise,

references to "Examiner" refers to the Examiner of record while reference to or use of

the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

This paper is given Paper No. 20090607 by the Examiner. This Paper No. is for

reference purposes only.

Status of Claims

Claims *20, 21, 23-32, 34-39* are currently pending and have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

    The specification shall conclude with one or more claims particularly
    pointing out and distinctly claiming the subject matter which the
    applicant regards as his invention.

Claims 20, 21, 23-32, 34-39 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

Claims 20 and 21 recite methods for carrying out an electronic transactions comprising many steps such as: "*a data interchange is performed between a first network subscriber node and a second network subscriber node with a first terminal at the first network subscriber node via a first communication network for stipulating transaction data for the transaction; an identification number for a second terminal at the first network subscriber node in a second communication network, different than the first, is input into the first terminal at the first network subscriber node by the first network subscriber node; the identification number and the transaction data are transmitted from the first network subscriber node to a third network subscriber node via a third communication network; the validity of the identification number is verified by the third network subscriber node, and an associated service provider node from a plurality of service provider nodes registered with the third network subscriber node is identified using the identification number; the verified identification number and the transaction data are transmitted from the third network subscriber node to the associated service provider node via a fourth communication network; a credit stipulated by the transmitted transaction data is reserved at the associated service provider node for the second network subscriber node by debiting an account at the first network subscriber node, which account is managed at the associated service provider node for the identification number, and the reserved credit is confirmed by the associated provider node to the third network subscriber node via the fourth communication network; a transaction number is generated and the transaction number is transmitted from the third network subscriber node to the second terminal at the first network subscriber node via the*

second communication network; the transmitted transaction number is input into the first

terminal at the first network subscriber node and the input transaction number is

transmitted to the third network subscriber node via the third communication network;

the transmitted transaction number is verified by the third network subscriber node by

comparing it with the transaction number generated previously by the third network

subscriber node; and the credit reserved by the associated service provider node is

confirmed by the third network subscriber node to the second network subscriber node

via the third communication network; a data interchange is performed between a first

network subscriber node and a second network subscriber node with a first terminal at

the first network subscriber node via a first communication network for stipulating

transaction data for the transaction; an identification number for a second terminal at the

first network subscriber node in a second communication network, different than the

first, is input into the first terminal at the first network subscriber node by the first

network subscriber node; the identification number and the transaction data are

transmitted from the first network subscriber node to a third network subscriber node via

a third communication network; the validity of the identification number is verified by the

third network subscriber node, and an associated service provider node from a plurality

of service provider nodes registered with the third network subscriber node is identified

using the identification number; the verified identification number and the transaction

data are transmitted from the third network subscriber node to the associated service

provider node via a fourth communication network; a credit stipulated by the transmitted

transaction data is reserved at the associated service provider node for the second

network subscriber node by debiting an account at the first network subscriber node,
which account is managed at the associated service provider node for the identification
number, and the reserved credit is confirmed by the associated provider node to the
third network subscriber node via the fourth communication network; a transaction
number is generated and the transaction number is transmitted from the associated
service provider node to the second terminal at the first network subscriber node via the
second communication network; the transmitted transaction number is input into the first
terminal at the first network subscriber node and the input transaction number is
transmitted to the third network subscriber node via the third communication network;
the transmitted transaction number is forwarded from the third network subscriber node
to the associated service provider node via the fourth communication network;
the transmitted transaction number is verified by the associated service provider node
by comparing it with the transaction number generated previously by the associated
service provider node; the verified transaction number is confirmed by the associated
service provider node to the third network subscriber node via the fourth communication
network; and the credit reserved by the associated service provider node is confirmed
by the third network subscriber node to the second network subscriber node via the
third communication network; conclusion of the transaction is confirmed by the second
network subscriber node to the third network subscriber node via the third
communication network; conclusion of the transaction is confirmed by the third network
subscriber node to the associated service provider node via the fourth communication
network; and the credit reserved to the second network subscriber node is posted by

the associated service provider node." However, Applicant has not positively recited

any methods steps above. Those steps just describe how the "data interchange is

performed" (in passive form, and the step does not necessarily perform any data

interchange!) instead of "performing ..." (in positive form), how the "identification

number is inputted into the first terminal" instead of "inputting ...", etc.

All other claims, i.e., claims 23-32, 34-39 are also rejected under 35

U.S.C. 112, second paragraph, for the same reason as above, by dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless –*
>
> *(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High

Technology Technical Amendments Act of 2002 do not apply when the reference

is a U.S. patent resulting directly or indirectly from an international

application filed before November 29, 2000. Therefore, the prior art date of

the reference is determined under 35 U.S.C. 102(e) prior to the amendment by

the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 20, 21, 23-32, 34-39 are rejected under 35 U.S.C. 102(e) as being

anticipated by US **2004/0039651 A1** (**Grunzig et al.**; hereafter "Grunzig").

Grunzig discloses a method for carrying out an electronic transaction, having the

following steps:

a data interchange is performed between a first network subscriber node and a

second network subscriber node with a first terminal at the first network subscriber node

via a first communication network for stipulating transaction data for the transaction; an

identification number for a second terminal at the first network subscriber node in a

second communication network, different than the first, is input into the first terminal at

the first network subscriber node by the first network subscriber node; the identification

number and the transaction data are transmitted from the first network subscriber node

to a third network subscriber node via a third communication network; the validity of the

identification number is verified by the third network subscriber node, and an associated

service provider node from a plurality of service provider nodes registered with the third

network subscriber node is identified using the identification number; the verified

identification number and the transaction data are transmitted from the third network

subscriber node to the associated service provider node via a fourth communication

network; a credit stipulated by the transmitted transaction data is reserved at the

associated service provider node for the second network subscriber node by debiting an

account at the first network subscriber node, which account is managed at the

associated service provider node for the identification number, and the reserved credit

is confirmed by the associated provider node to the third network subscriber node via

the fourth communication network; a transaction number is generated and the

transaction number is transmitted from the third network subscriber node to the second

terminal at the first network subscriber node via the second communication network;

the transmitted transaction number is input into the first terminal at the first network

subscriber node and the input transaction number is transmitted to the third network

subscriber node via the third communication network; the transmitted transaction

number is verified by the third network subscriber node by comparing it with the

transaction number generated previously by the third network subscriber node; and

the credit reserved by the associated service provider node is confirmed by the third

network subscriber node to the second network subscriber node via the third

communication network; a data interchange is performed between a first network

subscriber node and a second network subscriber node with a first terminal at the first

network subscriber node via a first communication network for stipulating transaction

data for the transaction; an identification number for a second terminal at the first

network subscriber node in a second communication network, different than the first, is

input into the first terminal at the first network subscriber node by the first network

subscriber node; the identification number and the transaction data are transmitted from

the first network subscriber node to a third network subscriber node via a third

communication network; the validity of the identification number is verified by the third

network subscriber node, and an associated service provider node from a plurality of

service provider nodes registered with the third network subscriber node is identified

using the identification number; the verified identification number and the transaction

data are transmitted from the third network subscriber node to the associated service

provider node via a fourth communication network; a credit stipulated by the transmitted

transaction data is reserved at the associated service provider node for the second

network subscriber node by debiting an account at the first network subscriber node,

which account is managed at the associated service provider node for the identification

number, and the reserved credit is confirmed by the associated provider node to the

third network subscriber node via the fourth communication network; a transaction

number is generated and the transaction number is transmitted from the associated

service provider node to the second terminal at the first network subscriber node via the

second communication network; the transmitted transaction number is input into the first

terminal at the first network subscriber node and the input transaction number is

transmitted to the third network subscriber node via the third communication network;

the transmitted transaction number is forwarded from the third network subscriber node

to the associated service provider node via the fourth communication network;

the transmitted transaction number is verified by the associated service provider node

by comparing it with the transaction number generated previously by the associated

service provider node; the verified transaction number is confirmed by the associated

service provider node to the third network subscriber node via the fourth communication

network; and the credit reserved by the associated service provider node is confirmed

by the third network subscriber node to the second network subscriber node via the

third communication network; conclusion of the transaction is confirmed by the second

network subscriber node to the third network subscriber node via the third

07 June 2009

communication network; conclusion of the transaction is confirmed by the third network

subscriber node to the associated service provider node via the fourth communication

network; and the credit reserved to the second network subscriber node is posted by

the associated service provider node (see at least **Abstract, paragraphs 0001, 0002,**

0008, 0010, 0012, 0015 - 0024, 0026 - 0045).

Response to Arguments

Applicant's arguments, see Amendment, filed 03/13/2009, with respect to the

rejection of claims 1-20 under Yates (US 2004/0064406 A1) have been fully considered

and are persuasive. Therefore, the rejection has been withdrawn. However, upon

further consideration, a new ground(s) of rejection is made as above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

US 20030097342 A1

US 20030110137 A1

US 20040230536 A1

US 7328844 B2

Examiner has cited particular columns and line numbers and/or paragraph and/or

page numbers in the prior arts of record as applied to the claims above in the body of

this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to fully consider the references in its **entirety** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is **(571) 272-7066**. The

07 June 2009

examiner can normally be reached on Monday - Friday, 9am - 6:00pm Eastern

Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, ANDREW J. FISCHER can be reached on **(571) 272-6779**.

For ***official/regular communication***, the fax number for the organization where

this application or proceeding is assigned is *(571) 273-8300*.

For ***informal/draft communication***, the fax number is *(571) 273-7066*

(**Rightfax**).

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at **866-217-9197 (toll-free).**

NANCY T. LE
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621

07 June 2009